

REMARKS

Reconsideration is requested.

Claims 3-5 have been objected because of informalities. Applicants have amended claims 3-5 as suggested by the Examiner, thus overcoming the Examiner's objection.

In the Office Action Summary, the Examiner indicates that the specification is objected to. However, no rejection is contained in the body of the office action. Applicant's attorney is unaware of any defect in the specification. Applicant's attorney assumes that the checkbox was selected in error absent specific rejections.

Claims 1-5, and 24-28 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,863,232 to Kwa, in view of U.S. Patent No. 5,631,988 to Swirhun et al.

The rejection is traversed. Kwa teaches away from any such combination of references. More particularly, Kwa states in Col. 1, lines 45 to 60 (in discussing problems with the prior art) that:

Most optical connector parts are provided with screw or bayonet type fittings. Thus, tee optical connector parts must be rotatably mated after the circuit boards are inserted and rotatably unmated before the circuit boards are withdrawn. The optical connector parts must be mounted where they are manually accessible when the circuit boards are mounted in the frame, for example at the front of the frame. This is not always convenient or

possible, particularly when the frame carries a large number of densely packed circuit boards. Moreover, operators may forget to rotatably mate the optical connector parts when inserting a circuit board, leaving the circuit board optically disconnected, or may forget to rotatably unmate the optical connector parts when removing a circuit board, physically damaging the circuit board, connector parts or optical fibers.

Kwa then goes on to state in Col. 2, lines 4 to 16 (in discussing problems with the prior art) that:

Unfortunately, in the known board edge optical connector arrangements the circuit board mounted optical connector parts are mounted at leading edges of the circuit boards. These leading edges are already congested with board edge electrical contacts. Moreover, in the known board edge optical connector arrangements the frame mounted optical connector parts are mounted at the back plane which is already congested with electrical board edge connectors and electrical conductors.

The present invention provides an optical connector which can be used to avoid some or all of the problems described above.

Kwa solves the problem of risk of operators forgetting to mate optical connector parts when inserting a circuit board or of forgetting to unmate optical connector parts when removing a circuit board by providing card guides 112

such that (see Col. 4, lines 8 to 44) sliding insertion of the circuit boards 140 into the card guides 112 urges the board edge electrical contacts 142 into the board edge electrical connectors 116 to electrically interconnect the circuit boards, and align the optical connector parts 120, 150 in a direction transverse to the direction of insertion.

Thus, Kwa itself teaches away from a system that does not provide for automatic alignment of optical connector parts. The main purpose of Kwa is to avoid the risk of operators forgetting to mate optical connector parts when inserting a circuit board or of forgetting to unmate optical connector parts when removing a circuit board by providing card guides 112.

Therefore, Kwa teaches away from the combination with Swirhun et al. The combination of references is improper and the rejection should be withdrawn.

In addition, the Federal Circuit discussed proper motivation *In re Lee*, 61 USPQ 2d 1430 (Fed. Cir. 2002). The motivation identified in the Office Action is akin to the conclusory statements set forth in *In re Lee* which were found to fail to provide the requisite motivation to support an obviousness rejection. The Court in *In re Lee* stated the factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. The Court in *In re Fritch*, 23 USPQ 2d 1780, 1783 (Fed. Cir. 1992) stated motivation is provided only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art that would lead that individual to combine the relevant teachings of the references. The

Lee Court stated that the Examiner's conclusory statements in the Lee case do not adequately address the issue of motivation to combine. The Court additionally stated that the factual question of motivation is material to patentability and cannot be resolved on subjective belief and unknown authority. The Court also stated that deficiencies of cited references cannot be remedied by general conclusions about what is basic knowledge or common sense. The Court further stated that the determination of patentability must be based on evidence.

In the instant case, the record is entirely devoid of any evidence to support motivation to combine the teachings apart from bald conclusory statements which are insufficient for proper motivation as set forth by the Federal Circuit. There is absolutely no evidence that the device of Kwa is deficient with respect to where optical interconnects are located such that one would be motivated to look for other solutions or that any improvement would result from the combination of the reference teachings. The only rationale is the subjective opinion of the Examiner improperly based upon Applicants' own disclosure. There is no motivation to combine the referenced teachings, and the Office has failed to establish a *prima facie* rejection for at least this reason.

The motivation recited in Col. 1, line 63 to Col. 2, line 16 of Swirhun et al. would appear to have been addressed by Swirhun et al. alone, without any need for a combination with Kwa.

Therefore, the combination of references is improper and all rejections relying on this combination of references are improper and should be withdrawn.

Claims 6-7 and 29-30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,863,232 to Kwa and U.S. Patent No. 5,631,988 to Swirhun et al., and further in view of U.S. Patent No. 4,704,599 to Kimmel and the publication by Gillingham, titled "SLDRAM: High-Performance Open-Standard Memory" (hereinafter referred to as "Gillingham").

Claims 6-7 and 29-30 are allowable because the combination of Kwa with Swirhun et al. is improper, for the reasons provided above. Further, without a proper motivational rationale to support the additional combination with Gillingham, the combination with this additional reference is also improper.

Claims 14-16, 18-21, 23, 31-33 and 35-37 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,863,232 to Kwa in view of U.S. Patent No. 4,704,599 to Kimmel and Gillingham.

Claims 14-16, 18-21, 23, 31-33 and 35-37 are allowable because the combination of Kwa with Kimmel and Gillingham is improper. The Kwa reference teaches away from such a combination.

Claims 17, 22, 34 and 38 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 4,704,599 to Kimmel, Gillingham, and U.S. Patent No. 4,863,232 to Kwa, and further in view of U.S. Patent No. 4,839,829 to Freedman.


Claims 17, 22, 34 and 38 are allowable because the combination of Kwa with Kimmel, Gillingham, and Freedman is improper. The Kwa reference teaches away from such a combination.

In view of the foregoing, allowance of claims 1-7 and 14-38 is requested.

The Examiner is requested to phone the undersigned at any time in the event that the next Office Action is one other than a Notice of Allowance.

Respectfully submitted,

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